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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,819

01/16/2007

Jean Mondet

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

YEAGER, RAYMOND P

ART UNIT

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4121

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,819	Applicant(s) MONDET ET AL.	
	Examiner RAYMOND P. YEAGER	Art Unit 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 60-115 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application 10/563,819 (01/16/2007) is a national stage entry of PCT/FR04/01202 (05/14/2004) per 35 USC 371 and claims benefit of US Provisional Application 60/495,726 (08/18/2003) per 35 USC 119e and claims foreign priority to French application 03/50299 (07/07/2003) per 35 USC 119. Claims 60 to 115 are pending.

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Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim 60 to 111 and 115 are drawn to *cosmetic composition*.

Group II, claim 112 is drawn to *a cosmetic process of using a makeup*.

Group III, claim(s) 113 to 114 are drawn to *a cosmetic process for making a makeup*.

2. As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." Moreover, as stated in PCT rule 13.2, "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled

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only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.” Furthermore, Rule 13.2 defines “special technical features” as “those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art”

3. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

The special technical feature of Group I is composition comprising *a liposoluble modified cellulose or a liposoluble modified cellulose derivative*. The composition comprising a liposoluble modified cellulose or a liposoluble modified cellulose derivative of claim I does not present a contribution over the prior art. As disclosed in US Patent 4,894,224 (Publication date: 01/16/1990), hereafter referred to as the ‘224 patent, the *liposoluble modified cellulose or liposoluble modified cellulose derivative* of instant claim I is not novel.

- **Instant claim 60:** “A cosmetic composition for making up the skin, the lips, the eyelashes or the nails, comprising, in a cosmetically acceptable medium,” –The portions of the preamble which refer to a composition which is cosmetic and an intended use for making up the skin, lips, eyelashes, or nails is not afforded patentable weight. If these portion were afforded patentable weight, the composition in the ‘224 patent claims the same components and per MPEP § 2112 would be able to be applied to the same purpose. The ‘224 patent discloses a cosmetic and medicinal composition (abstract).

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Further, the '224 patent discloses cosmetic use on the hair (page 1, column 1, lines 5-11) and skin (page 1, column 1, lines 50 to 58).

- *“a liquid fatty phase and”* – The '224 patent claims a composition comprising 30 to 90 percent volatile cyclic silicone oil and 5 to 50 percent nonvolatile oil (page 7, claim 1). The composition is liquid as disclosed in the abstract (page 1). These components are the same as claimed in the instant application which claims cyclic volatile silicones (claim 87) and a nonvolatile oil (claim 90) as part of the liquid fatty phase.
- *“at least one cellulose chosen from liposoluble modified cellulose and liposoluble modified cellulose derivatives, the modified cellulose or the modified cellulose derivative comprising free hydroxyl functional groups totally or partially replaced with hydrophobic groups chosen from the radicals of formula -OYR, wherein:”* – The '224 patent claims 2 to 30 percent of a cellulose ether having formed ester-forming substituent groups derived from a fatty acid having 10 to 20 carbon atoms in a molecule. The cellulose derivative is prepared by esterifying an alkyl cellulose, hydroxyalkyl cellulose, or hydroxyalkyl cellulose by a conventional method of esterification using an acid anhydride or an acid chloride as the esterifying agent (page 3, line 66 to page 4, line 9). The process in of making the modified cellulose ether in the '224 patent is substantially similar to the process of making the cellulose ether in the instant application (page 89-90, example 1). As the processes are substantially similar the products would result in the same products per MPEP §

2112. Thus, the esterification process in the '224 patent would at least partially replace the free hydroxyl functional groups.

- “- *R is chosen from: A) hydrocarbon-based groups comprising linear or branched, saturated or unsaturated chains, or saturated or unsaturated rings, comprising 8 to 50 carbon atoms for the at least one modified cellulose or 4 to 50 carbon atoms for the at least one modified cellulose derivative, the groups optionally comprising in their chains at least one aromatic group and/or at least one hetero atom chosen from O, N, P, Si, and S; the groups possibly being fluorinated or perfluorinated; and B) groups of polymeric nature chosen from polyolefins, hydrogenated or non-hydrogenated polydienes and lipophilic polycondensates, and*
- “- *Y is chosen from a single bond or a divalent bonding group.*” – The process of preparing the liposoluble modified cellulose (derivative) would result in the same products in the '224 patent and the instant application as discussed *supra*.

As such, Group I does not share a special technical feature with the instant claims of Group II. Therefore, the claims are not so linked with the meaning of PCT Rule 13.2 so as to form a single inventive concept, and unity between Groups I-II is broken.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election of Species

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

7. The applicant must elect the following species:

- If applicant elects Group I, the following species elections are required:
 - The applicant must elect *a single disclosed composition* and each compound present in the composition: A. The applicant must elect the composition from examples 2 to 5 on pages 91 to 93 and specify the claimed function or role for each component (i.e. film-forming polymer, gelling agent, volatile oil, etc.) and specify which claims the elected *single disclosed composition* reads on OR B. alternatively specify each component of a *single composition* as follows:
 - One specific compound from the group of liposoluble modified cellulose and liposoluble modified cellulose derivatives. Claims 60 and 63 are generic for this species. In addition, the applicant must also elect:
 - One species from the group of species for the *variable Y*;
 - One species from the group of species for the *variable R*;
 - The applicant must elect whether the composition is aqueous or anhydrous;

- The applicant must elect one *volatile oil* (disclosed on the top of page 49) and/or one *nonvolatile oil* (*nonvolatile oils* are disclosed on the bottom of page 49 to the bottom of page 51) in the liquid fatty phase.
- The applicant must elect whether the following species are present or absent in the composition. If all of these species are absent, claims 60 and 63 are generic for these species. If any one of these species is present, no claims are generic for this species. If a species is elected as present in the single composition the applicant must elect one single compound for each component of the species.
 - *An additional film-forming;*
 - *dyestuff;*
 - *a fatty;*
 - *a filler;*
 - *a gelling agent;*
 - *a cosmetic adjuvant;*
- For each compound the applicant elects the applicant must provide the name of the compound and if the compound used has a trade name, the trade name must be provided. The applicant is also reminded that upon electing a species the applicant must elect a species for which the instant application provides support. If the applicant elects a species which is not supported in the instant application, such an election would be considered an addition of new matter.
- If applicant elects Group II, the following species elections are required:

- One specific compound from the group of *liposoluble modified cellulose and liposoluble modified cellulose derivatives*. Claims 60 and 63 are generic for this species. In addition, the applicant must also elect:
 - i. One species from the group of species for the *variable Y*;
 - ii. One species from the group of species for the *variable R*;
- If applicant elects Group III, the following species elections are required:
 - One specific compound from the group of *liposoluble modified cellulose and liposoluble modified cellulose derivatives*. Claims 60 and 63 are generic for this species. In addition, the applicant must also elect:
 - iii. One species from the group of species for the *variable Y*;
 - iv. One species from the group of species for the *variable R*.

Specifically, Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. Upon Applicant's election of species, the result must provide a single chemical species and a single condition or disease to be treated or improved. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, one *single disclosed composition, the compound for each component, and the function/role for each component* as discussed *supra* OR one *single composition* (including one specific *liposoluble modified cellulose* (or derivative), *variable Y*, *variable R*, one *volatile*

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oil and/or nonvolatile oil, and if elected as present one *additional film-forming, dyestuff, fatty substance, filler, gelling agent, cosmetic adjuvant* and whether the composition is aqueous or anhydrous as discussed *supra* for group I, one specific *liposoluble modified cellulose or liposoluble modified cellulose derivative* (including one species for *variable Y* and one species for *variable R*) for group II, one specific *liposoluble modified cellulose or liposoluble modified cellulose derivative* (including one species for *variable Y* and one species for *variable R*) for group III, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 60 and 63 may be generic for group I, claims 112 is generic for group II, claims 113 and 114 are generic for group III.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding technical feature for the following reasons as discussed *supra*.

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitation of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAYMOND P. YEAGER whose telephone number is (571)270-7681. The examiner can normally be reached on Mon - Fri 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

R.P.Y.

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4121

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